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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,769	10/30/2003	Elena Grassi	Q78055	6931

23373 7590 05/02/2005

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EXAMINER


LAVARIAS, ARNEL C

ART UNIT PAPER NUMBER

2872

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,769	<b>Applicant(s)</b> GRASSI ET AL. 	
	<b>Examiner</b> Arnel C. Lavarias	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/30/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments to Claims 3, 5, and 8 in the Preliminary Amendment submitted 10/30/03 are acknowledged and accepted.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

3. The drawings were received on 10/30/03. These drawings are objected to for the following reason(s) as set forth below.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

Figure 5- Reference numerals 122, 242.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are

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not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. *It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.*

6. The abstract of the disclosure is objected to because of the following informalities:

Abstract, line 1- 'Disclosed is a' should read "A".

Correction is required. See MPEP § 608.01(b).

7. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.

(b) CROSS-REFERENCE TO RELATED APPLICATIONS.

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- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

8. The disclosure is objected to because of the following informalities:

Section headings for each section of the specification are missing. See Section 5 of this Office Action regarding section headings.

Page 1, line 23- 'bigger' should read 'big'

Page 2, line 24- 'dicroic' should read 'dichroic'

It is general USPTO policy that specific references to claim numbers not be included within the specification of the disclosure, since claims will generally change, either in presence, content, or scope, during the prosecution of the application. Such changes may render the specification unclear or indefinite. Specific instances in the instant application include: Page 4, lines 4-5.

Page 4, line 11- insert 'of' after 'part'.

Appropriate correction is required.

### *Claim Objections*

9. Claims 2, 4-5, 9-10 are objected to because of the following informalities:

Claim 2, lines 1-2 recites the limitation '...it further comprises...'. It is unclear what is being referred to here. For purposes of examination, this limitation has been taken to mean '...the telescope further comprises...'. Claim 4 is dependent on Claim 2, and hence inherits the deficiencies of Claim 2.

Similarly, Claim 5, line 3 recites the limitation '...it further comprises...'. It is unclear what is being referred to here. For purposes of examination, this limitation has been taken to mean '...the telescope further comprises...'.

Claims 4-5 both recite the limitation "the reflecting surface" in line 2 of Claim 4 and line 3 of Claim 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 9-10 both recite the limitation "the reflecting optical surface" in line 2 of each of Claims 9-10. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 5-8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kadrmas (U.S. Patent No. 3781552).

Kadrmas discloses a bi-directional telescope for a laser on air telecommunication system and method for receiving-transmitting an optical signal through a bi-directional telescope for a laser on air telecommunication system (See for example Figures 1-2), both the telescope and method comprising (providing) a primary optical surface (See for example 50 in Figure 1); (providing) at least one transmitting device (See for example 22 in Figure 1) forming at least one illuminated area (See for example 46, 48 in Figure 1), the at least one transmitting beam having a corresponding axis; (providing) a receiving device (See for example 72 in Figure 1) collecting the power deflected by an optical surface (See for example 52 in Figure 1) of the primary optical surface into a receiving beam, the receiving beam having an axis; characterized in that the optical surface of the primary optical surface is larger than the at least one illuminated area (See 50, 48 in Figure 1) and in that the transmitting beam axis does not coincide with the receiving beam axis (It is noted that the optical axes of both the receivers 72 and the source laser 22 are not coincident). Kadrmas further discloses the telescope further comprising (providing) a secondary optical surface (See for example 56 in Figure 1), wherein the

received power deflected by the optical surface of the primary optical surface is focused (See for example 25 in Figure 1) by the secondary optical surface into the receiving beam; the primary optical surface comprising a hole (See for example hole in 50 of Figure 1); the secondary optical surface comprising holes (See hole in 56 of Figure 1); and the at least one transmitting device being placed fundamentally behind the reflecting surface (See 22, 50 in Figure 1, where 'behind' has been taken to be the locations where the reflective optical surface of element 50 does not face) and that the telescope further comprises means for deflecting the transmitting beam towards the secondary optical surface (See for example 38 in Figure 1).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadrmas in view of Weiss (U.S. Patent No. 3371212).

Kadrmas discloses the invention as set forth above in Claims 1-2, 6-7, except for the at least one transmitting device being placed fundamentally in front of the reflecting surface. However, it is well known in the art for such transmitting telescopic optical systems to place the transmitter or source either behind or in front of the reflecting face of the main reflector of the telescopic optical system. For example, Weiss teaches a



conventional transmitting and receiving telescopic optical system (See Figure), wherein the transmitting optical source (See 50 in Figure) is placed in front of (i.e. in locations where the reflecting surface of the primary mirror face) the reflecting surface of the main reflector (See 12 in Figure) of the telescope. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the at least one transmitting device be placed fundamentally in front of the reflecting surface, as taught by Weiss, in the telescope and method of Kadrmas, for reducing the physical size of the telescope optical system, while making the source readily accessible for replacement if the source is damaged or requires replacement.

### *Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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4/28/05